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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,139	10/19/1999	HUGH WILLIAMS ADAMS JR	YO996-244X	3708

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EXAMINER
RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
2175	14

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No.	Applicant(s)	
	09/421,139	WILLIAMS ADAMS JR ET AL.	
	Examiner	Art Unit	
	Sam Rimell	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-14,16-19,21-23,31-36,38,39 and 44-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 11-14, 16-19, 21-23, 31-36, 38, 39, 44-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of the independent claims 1, 7, 21 and 31 have been mended to recite a "dynamic generation" of lesson content. This feature does not appear to exist in the disclosure as originally filed. In addition, the original disclosure does not anywhere include the word "dynamic" or "dynamically".

Claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of independent claims 1, 7, 21 and 31, the word "dynamic" is indefinite. While the word "dynamic" is itself known, the interpretation and meaning of this word within the context of the invention is unknown, particularly since this word does not appear in the original disclosure.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 11-14, 16-19, 21-23, 31-36, 38-39 and 44-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Mostow et al. (U.S. Patent 5,920,838).

Claim 1: FIG. 1 of Mostow et al. discloses user input means (headset 14) which include an audio input means (microphone) and speech recognition means (20). A user interface (12) includes audio output means (headphones on headset 14). A program controller means (22) exists to control the application of a lesson. The system further includes a plurality of distinct databases, collectively referred to as a knowledge base (24). One such set of databases are lesson databases which provides the stories which the student is intended to read (stories, novels and libraries recited at col. 5, line 26). Another such set of databases are the lesson based speech interpretation databases (sets of text segments recited at col. 5, lines 26-30, and pronunciation database recited at col. 8, lines 45-50).

Claim 2: Col. 5, line 27 recites a database of text segments which include word fragments. Such fragments can constitute incorrect responses, such as expected mispronunciations (col. 5, lines 1-12).

Claim 3: Column 8, line 45 recites a database which includes a lexicon of word pronunciations, which read as a set of correct student responses.

Claim 4: The sound effects recited at col. 5, lines 32-33) read as acoustical information.

Claim 5: The acoustical information relates to the speech processing system.

Claim 6: The computer (12) includes a monitor which serves as a visual output means.

Claim 7: See remarks for claim 1. In addition, the system of Mostow et al. includes a lesson storage database for storing the lesson and the output produced by the student (col. 6, lines 35-44).

Claim 8: The visual output means is the monitor at computer (12). The controller (22) can recall data from the lesson storage database (26) and display this information on the output means.

Claim 9: Column 8, lines 53-54 suggests that the data for a lesson may be imported from a "pre-existing" source. Such a source would necessarily be another computer system from which the data is imported.

Claim 11: The controller (22) monitors the student's progress using a quality control module (col. 9, lines 11-13).

Claim 12: Student progress information is stored at database (26), after it is generated by interaction between the controller (22) and the student.

Claim 13: The controller (22) can alter the level of interaction (col. 4, lines 56-65).

Claim 14: The headset (14) generates audio output.

Claim 16: See remarks for claim 11.

Claim 17: See remarks for claim 12.

Claim 18: See remarks for claim 13.

Claim 19: See remarks for claim 14.

Claim 21: See remarks for claims 1, 2, 3, 4.

Claim 22: Database (26) is a lesson storage database.

Claim 23: The controller (22) monitors student progress using the quality control module (33) and can alter the level of interaction (col. 4, lines 56-65).

Claim 31: See remarks for claim 1.

Claim 32: Information about the student level and student responses can be retrieved from the lesson storage database (26) and can be used to decide which lessons to present (col. 6, lines 35-44).

Claim 33: See remarks for claim 11.

Claim 34: See remarks for claim 12.

Claim 35: See remarks for claim 13.

Claim 36: See remarks for claim 14.

Claim 38: See remarks for claim 7.

Claim 39: See remarks for claim 8.

Claim 44: The database (26) containing stored student responses defines a reading level database.

Claim 45: The system may include a database of story text (col. 5, line 26).

Claim 46: The system may include a database of story pages (col. 5, line 26).

Claim 47: Any database defined in the system of Mostow et al. reads as a session database.

Claim 48: The system allows for replay (The "Back" function, col. 3, line 20).

Claim 49: Any point in the lesson which is started by the controller may be read as the claimed starting point.

Claim 50: A database providing audio output (col 5, lines 32-33) may be used to generate audio output.

Claim 51: Any text database within the system of Mostow et al. reads as a "text power set" database.

Remarks

Examiner response has been fully considered.

Applicant's response is composed of an affidavit submitted under 37 CFR 1.131 and remarks pertaining to each of the grounds of rejection as set forth in the previous office action. No amendments to the claims are presented.

Affidavit under 37 CFR 1.131:

The affidavit under 37 CFR 1.131 asserts that the present invention was "made at least by June 2, 1997". Computer archive records are provided showing a series of 33 files. One of the files ("Read.C") is provided in detail, and contains a computer program. The file "Read.C" has a last modification date of November 20, 1995.

Examiner has reviewed this information and finds that the information provided is not effective in overcoming the application of the Mostow et al. patent reference, by reason that information provided in the affidavit is incomplete.

MPEP 715.07 states:

"The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or here invention prior to a particular date. Vague and general statements in broad terms about what the exhibits describe, along with a general assertion that the exhibits describe a reduction to practice amounts essentially to mere

pleading, and thus does not satisfy 37 CFR 1.131(b). See *In re Borowski* 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by applicant. See *In re Harry* 333 F.2d 920, 142 USPQ 164 (CCPA 1964).

In the present affidavit, applicant does not provide an explanation of the computer program "Read. C", which is being relied upon to establish the prior reduction to practice. While the program does contain comments on individual programming lines, the overall effect of the program cannot be determined, so as to permit a comparison of this program to the claimed invention. In addition, it is not clear whether "Read.C" alone is considered to be the reduction to practice, or whether the reduction to practice is based upon all 33 files in the file archive.

Accordingly, the affidavit is not effective in overcoming the application of the Mostow et al. patent reference.

Rejections under 35 USC 112 first and second paragraphs:

Applicant takes issue with the Examiner's findings that "dynamic generation" of lesson content is new matter. While applicant agrees that the terminology is not explicitly described in the original specification, it is indirectly implied in various quotations cited from the specification.

The problem which arises is that the term "dynamic generation" is so broad that it implies processes and systems that are beyond the scope of applicant's original disclosure. For example, if the lessons generated for the student were decided based upon some specific mathematical formula, such as Bayes theorem or fuzzy logic, this would be a dynamic determination that clearly would not be within the scope of applicant's original disclosure.

This also leads to the rejection under 35 USC 112 second paragraph. Since the term "dynamic generation" is broad in scope and not discussed in the specification, it is not clear what applicant meant to be the range of possibilities for this language. Thus, in addition to being new matter, the term raises an issue of indefiniteness.

The rejection of the phrase "text power set" has been withdrawn in view of applicant's arguments.

Rejection under 35 USC 102(e) involving Mostow et al.:

In reviewing applicant's arguments, it is first noted that applicant presents arguments in reference to claims which have be cancelled. For example, applicant presents arguments with respect to claims 26, 30, 31 and 43, each of which have been cancelled. Arguments or amendments presented for cancelled claims are moot and will not be considered.

Applicant argues that Mostow et al. does not disclose a database of incorrect student responses. However, Mostow et al. discloses a knowledge base of text segments (col. 5, lines 23-34). This knowledge base not only includes reference to correct verbal responses, it also includes mispronunciations (col. 5, lines 1-12). Since the responses by the student in the Mostow et al. system are text segments, this knowledge base of mispronunciations will clearly anticipate the requirement for a database containing incorrect student responses.

Applicant argues that Mostow et al. does not disclose a database of acoustic information. However, col. 5, lines 32-33 of Mostow et al. refer to a number of distinct types of sound effects, such as spoken pronunciations and sound effects, each of which is clearly readable as acoustic information.

Applicant argues that Mostow et al. does not disclose a reading level information database. Examiner maintains that the database (26) containing stored student responses is a reading level database. In Mostow et al., this database will contain information about the age of the user, the words that the user has trouble with and the words that the user has mastered. This information is clearly indicative of a user's reading level.

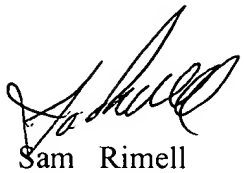
Applicant argues that Mostow et al. does not disclose a session database. Given that the claims do not define what constitutes a "session", examiner maintains that any of the databases in the Mostow et al. patent would read as a "session database".

Applicant also argues that Mostow et al. does not disclose a replay function. However, col. 3, lines 13 and 20 of Mostow et al. refers to a "Back" function which allow a user to return to a previous sentence. The previous sentence is replayed (re-displayed) back to the user.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



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